

REMARKS

The Office Action mailed October 13, 2006 has been carefully considered.
Reconsideration in view of the following remarks is respectfully requested.

Title of the Invention

The Title of the Invention has been changed in order to be more descriptive.

Rejection(s) Under 35 U.S.C. § 103(a)

Claims 1-2, 7-8, 16, 23-24, 29-30 and 38 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Lee et al. (U.S. pat. no. 6,535,493).

Claim 35 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Rue (U.S. pub. no. 2003/0185172) in view of Lee et al. (U.S. pat. no. 6,535,493) and Edney et al. (U.S. pub. no. 2004/0255033).

Claim 36 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Rue (U.S. pub. no. 2003/0185172) in view of Lee et al. (U.S. pat. no. 6,535,493).

Claims 3-6, 17-19 and 25-28 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Lee et al. (U.S. pat. no. 6,535,493) in view of Eglin (U.S. pub. no. 2003/0210671).

Claims 12, 15, 21, 34 and 40 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Lee et al. (U.S. pat. no. 6,535,493) in view of Rue (U.S. pub. no. 2003/0185172) and Strachan et al. (U.S. pub. no. 2004/0105440).

Claims 13 and 22 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Lee et al. (U.S. pat. no. 6,535,493), Rue (U.S. pub. no. 2003/0185172) and Strachan et al. (U.S. pub. no. 2004/0105440) and further in view of Edney et al. (U.S. pub. no. 2004/0255033).

Claim 14 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Lee et al. (U.S. pat. no. 6,535,493), Rue (U.S. pub. no. 2003/0185172) and Strachan et al. (U.S. pub. no. 2004/0105440) and further in view of Eglin (U.S. pub. no. 2003/0210671).

Claims 1, 12, 16, 21, 23, 34, 38 and 40 have been amended to indicate that the determination of whether the first switch is a home agent for the client is performed *in response to receipt of the roam request*. By comparison, in the registration procedure described in Lee, col. 8, lines 4-20, all the parties already know who the home agent is, and the procedure is simply one of configuring the communication path to the roaming client such that messages to the roaming client, which can no longer be sent directly from the known home agent to the client, are accordingly sent by way of the new, foreign agent. In particular, in step “2” of Lee, col. 8, lines 4-20, the request is relayed by the foreign agent to the *already-determined* home agent. In contrast, in Claim 1 for instance, the sequence of events is: 1. receiving the roam request, and, *subsequently*, 2. determining, in response to said receiving, if the first switch is a home agent. This situation is possible in the claimed invention because the request is sent “at large,” without knowledge or specificity as to who the home agent is, and identification of the home agent only occurs when the home agent responds to the request. In fact, the process is so democratic in this sense that in some cases the sender will also be the recipient of the request and will respond in the same manner expected of other recipients. These situations clearly illustrate the unobvious distinction of the presently claimed invention over Lee, and passage to allowance of Claims 1, 12, 16, 21, 23, 34, 38 and 40, and the claims dependent therefrom, is respectfully urged.

Claims 9-11, 20, 31-33, 37 and 39 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Rue (U.S. pub. no. 2003/0185172) in view of Eglin (U.S. pub. no. 2003/0210671). The Office Action acknowledges that Rue does not show a first switch that, in order to address the case of two VLANs serviced by the same switch, sends a roam request to itself as well as to peer switches. Importantly, Eglin does not show this feature either. All Eglin adds to the argument is the disclosure of two VLANs serviced by the same switch. Thus neither Eglin nor Rue show a switch that sends a roam request to itself as well as to peer switches. Therefore even if Rue and Eglin were combinable, the invention would not result. Accordingly,

a proper *prima facie* case of obviousness has not been made, and Applicants respectfully submit that the invention of Claims 9-11, 20, 31-33, 37 and 39 is patentable over Rue and Eglin. It will be recalled that, according to the Manual of Patent Examining Procedure (M.P.E.P.),

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.¹

The third criterion specifically—the prior art reference (or references when combined) must teach or suggest all the claim limitations—is not met because there is no teaching or suggestion in Rue or Eglin of a switch that sends a roam request to itself as well as to peer switches. Any such teaching in fact derives from applicants own disclosure, and the above passage from the MPEP expressly cautions against reliance on such a teaching, impermissibly grounded in hindsight, for an obviousness rejection.

Conclusion

In view of the preceding discussion, Applicants respectfully urge that the claims of the present application define patentable subject matter and should be passed to allowance.

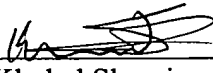
If the Examiner believes that a telephone call would help advance prosecution of the present invention, the Examiner is kindly invited to call the undersigned attorney at the number below.

¹ M.P.E.P § 2143.

Please charge any additional required fees, including those necessary to obtain extensions of time to render timely the filing of the instant Amendment and/or Reply to Office Action, or credit any overpayment not otherwise credited, to our deposit account no. 50-1698.

Respectfully submitted,
THELEN REID BROWN RAYSMAN & STEINER LLP

Dated: 01/16/2007


Khaled Shami
Reg. No. 38,745

THELEN REID BROWN RAYSMAN & STEINER LLP
P.O. Box 640640
San Jose, CA 95164-0640
Tel. (408) 282-1855
Fax. (408) 287-8040